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Paper No. 26

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In re Application of  
David Andrew D'Zmura  
Application No. 09/849,582  
Filed: May 5, 2001  
Attorney Docket No.: None  
Title: METHOD OF DETERMINING  
ZODIAC SIGNS

**OFFICE OF PETITIONS**

DECISION ON RENEWED PETITION  
UNDER 37 C.F.R. §1.137(A) AND  
PETITION UNDER 37 C.F.R. §1.137(B)

This is a decision on the renewed petition under 37 CFR 1.137(a)<sup>1</sup>, filed October 10, 2003<sup>2</sup>, and the petition under 37 C.F.R. §1.137(b), filed September 8, 2003<sup>3</sup>, to revive the above-identified application.

The above-identified application became abandoned for failure to submit the issue fee in a timely manner in reply to the Notice of Allowance and Issue Fee Due (notice), mailed June 2, 2003, which set a shortened statutory period for reply of three (3) months. No extensions of time are permitted for transmitting issue fees<sup>4</sup>. Accordingly, the above-identified application became abandoned on September 3, 2003.

On September 8, 2003, petitioner filed the original petition under 37 C.F.R. §1.137(a).

On September 22, 2003, the petition under 37 C.F.R. §1.137(a) was dismissed for failure to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 CFR 1.137(a).

<sup>1</sup> A grantable petition pursuant to 37 CFR 1.137(a) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(l);
- (3) A showing to the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable;
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

<sup>2</sup> A supplement to this petition was submitted on October 23, 2003.

<sup>3</sup> Petitioner filed the petition under 37 C.F.R. §1.137(b) with the original petition. It was not worked on so as to afford the applicant another opportunity to submit a renewed petition under the unavoidable standard.

<sup>4</sup> See MPEP §710.02(e).

The following was set forth:

The petitioner has asserted financial difficulty in that he lacked the funds necessary to pay the issue fee. A showing of "unavoidable" delay based upon financial difficulty must establish that petitioner lacked the financial resources to pay the fee(s) associated with patent prosecution. Such a showing must be supported by a **complete and thorough** (emphasis included) showing of his financial condition during the entire period between June 2, 2003 and September 8, 2003, including income, expenses, tax return statements, bank records, assets, credit and obligations, which made the delay in payment of the fee(s) unavoidable. Petitioner should provide copies of all documents or records pertaining to each of these so as to confirm the financial difficulty.

Decision on original petition, page 4.

The renewed petition under 37 C.F.R. §1.137(a):

**The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard.**

"In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. The Commissioner's interpretation of those provisions is entitled to considerable deference."<sup>5</sup>

"[T]he Commissioner's discretion cannot remain wholly uncontrolled, if the facts **clearly** demonstrate that the applicant's delay in prosecuting the application was unavoidable, and that the Commissioner's adverse determination lacked **any** basis in reason or common sense."<sup>6</sup>

"The court's review of a Commissioner's decision is 'limited, however, to a determination of whether the agency finding was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law.'"<sup>7</sup>

"The scope of review under the arbitrary and capricious standard is narrow and a court is not to substitute its judgment for that of the agency."<sup>8</sup>

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5 Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), aff'd without opinion (Rule 36), 937 F.2d 623 (Fed. Cir.1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg 849 F.2d 1422, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) ("an agency's interpretation of a statute it administers is entitled to deference"); see also Chevron U.S.A. Inc. v. Natural Resources Defence Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute."))

6 Commissariat A L'Energie Atomique et al. v. Watson, 274 F.2d 594, 597, 124 U.S.P.Q. (BNA) 126 (D.C. Cir. 1960) (emphasis added).

7 Haines v. Quigg, 673 F. Supp. 314, 316, 5 U.S.P.Q.2d (BNA) 1130 (N.D. Ind. 1987) (citing Camp v. Pitts, 411 U.S. 138, 93 S. Ct.1241, 1244 (1973) (citing 5 U.S.C. 706 (2)(A)); Beerly v. Dept. of Treasury, 768 F.2d 942, 945 (7th Cir. 1985); Smith v. Mossinghoff, 217 U.S. App. D.C. 27, 671 F.2d 533, 538 (D.C. Cir.1982)).

8 Ray v. Lehman, 55 F.3d 606, 608, 34 U.S.P.Q2d (BNA) 1786 (Fed. Cir. 1995) (citing Motor Vehicles Mfrs. Ass'n v. State Farm Mut. Auto. Ins. Co., 463 U.S. 29, 43, 77 L.Ed.2d 443, 103 S. Ct. 2856 (1983)).

### The standard

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."<sup>9</sup>

The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"<sup>10</sup> Nonawareness of a PTO rule will not constitute unavoidable delay<sup>11</sup>

The burden of showing the cause of the delay is on the person seeking to revive the application<sup>12</sup>.

A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP is not rendered "unavoidable" due to either the applicant's reliance upon oral advice from USPTO employees or the USPTO's failure to advise the applicant to take corrective action<sup>13</sup>.

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present<sup>14</sup>.

In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account"<sup>15</sup>.

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<sup>9</sup> Id.

<sup>10</sup> See In re Mattullah, 38 App. D.C. 497 (D.C. Cir. 1912).

<sup>11</sup> See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel.

<sup>12</sup> Id.

<sup>13</sup> See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

<sup>14</sup> In re Mattullah, 38 App. D.C. at (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

<sup>15</sup> Smith v. Mossinghoff, 671 F.2d at 538; 213 USPQ at 982.

A petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was “unavoidable”<sup>16</sup>.

### **The rule and portion of the MPEP relevant to the abandonment of this application**

37 CFR 1.311. Notice of Allowance.

- (a) If, on examination, it appears that the applicant is entitled to a patent under the law, a notice of allowance will be sent to the applicant at the correspondence address indicated in 37 C.F.R. §1.33. The notice of allowance shall specify a sum constituting the issue fee which must be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. The sum specified in the notice of allowance may also include the publication fee, in which case the issue fee and publication fee (37 C.F.R. § 1.211(f)) must both be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. This three-month period is not extendable.

710.02(e) Extension of Time

- (c) If an applicant is notified in a “Notice of Allowability” that an application is otherwise in condition for allowance, the following time periods are not extendable if set in the “Notice of Allowability” or in an Office action having a mail date on or after the mail date of the “Notice of Allowability”:
- (2) The period for submitting formal drawings set under 37 C.F.R. §1.85(c).

### **Application of the standard to the current facts and circumstances**

In the renewed petition, petitioner continues to maintain that the circumstances that led to the abandonment of the application meet the aforementioned unavoidable standard and, therefore; petitioner qualifies for relief under 37 CFR 1.137(a). In support thereof, petitioner contends that the funds required to submit the issue fee were not available until after the expiration of the period of reply.

The statement of facts submitted with the original petition set forth that when the applicant received the notice, he did not have the necessary funds in the forms of cash, his savings account, checking account, or credit cards. On August 16, 2003, petitioner attempted to sell his car to a dealership. Petitioner ended up purchasing a new car, leaving his old car at the dealer with instructions to return on August 21<sup>st</sup> to pick up a check for \$3,700. Petitioner returned as directed, only to have his new car repossessed by the dealer, and his old car returned to him. Obviously, the check in question was not provided to the applicant. On September 4, 2003, petitioner managed to sell his car for \$3,500, and the instant petition was filed shortly thereafter.

Petitioner’s arguments have been considered, and has been deemed to be unpersuasive.

The petitioner has asserted financial difficulty in that he lacked the funds necessary to pay the issue fee. A showing of “unavoidable” delay based upon financial difficulty must establish that petitioner lacked the financial resources to pay the fee(s) associated with patent prosecution. Such a showing must be supported by a **complete and thorough** showing of his financial condition during the entire period between June 2, 2003 and October 10, 2003 (the date of submission of the renewed petition), including income, expenses, tax return statements, bank records, assets, credit and obligations, which made the delay in payment of the fee(s) unavoidable.

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<sup>16</sup> Haines, 673 F. Supp. at 314, 316-17; 5 USPQ2d at 1131-32.

With the renewed petition, petitioner has submitted a page entitled "Schedule B – NOL Carryover (per Form 1045)." It is not clear what information petitioner means to convey with this page. Furthermore, this page does not appear to be a tax return statement, as it appears to be handwritten and does not seem to be generated by the Internal Revenue Service.

Petitioner has submitted bank statements for an account with the El Paseo Bank from May 16, 2003 – July 15, 2003<sup>17</sup>, as well as statements for an account with the Bank of America from July 16, 2003 – September 17, 2003. Activity with the Bank of America account subsequent to September 17, 2003 has not been provided.

Petitioner has not indicated whether he maintains any other bank accounts.

Petitioner has failed to reveal his income during the relevant time frame.

Petitioner has not delineated his expenses, and has only included a bill for a P.O. box.

No credits or obligations have been listed.

As such, the Office cannot determine whether the petitioner had the requisite funds during the relevant time period, if he had any income which could have been used to submit the required issue fee, or if he had any financial obligations which would have prevented the submission of the issue fee.

Consequently, the petition is **DISMISSED**.

The petition under 37 C.F.R. §1.137(b)

With the instant petition, the petitioner has made the proper statement of unintentional delay.

Petitioner has further inquired as to a refund of filing fees for independent claims in excess of three and dependent claims in excess of twenty, due to the subsequent restriction. Unfortunately, refunds are not available.

The receipt of form PTOL-85 is acknowledged.

The application file is being forwarded to the Office of Patent Publication for further processing into a patent

Telephone inquiries concerning *this decision* should be directed to the undersigned at (703) 305-0011. Questions pertaining to this application should be directed towards the Office of Patent Publication at (703) 305-8497.



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<sup>17</sup> Petitioner indicates that the account with El Paseo was closed on July 1, 2003.